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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,146	12/02/2003	Anna Molly Mathew		2799

7590 03/30/2006

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EXAMINER

FLOOD, MICHELE C

ART UNIT PAPER NUMBER

1655

DATE MAILED: 03/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/726,146

**Applicant(s)**

MATHEW ET AL.

**Examiner**

Michele Flood

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The instant claims are drawn to products of nature.

For instance, Moon teaches the genus *Caesalpinia* includes the tropical plant, *Caesalpinia sappan* (also known in the art of herbal medicine as Pathimukham), in Column 4, lines 22-38 (see \*A); on page 190, Lust teaches fenugreek (V), as an annual plant.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is generally narrative and indefinite, failing to conform to current U.S. practice. A claim must be only one sentence long and must be numbered. A claim

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must also be directed to one category of invention. For example, categories of invention are a composition, a method of making a composition, and a method of using a composition. In the present claim, it is unclear if Applicant intends to direct the subject matter of the claimed invention to a composition or several compositions or a method of making the composition or a method of using the composition. For examples of proper claim language, please see the following \*patents. See U.S. Patent No. 6,093,404 for an example of proper claim language for a composition claim. See U.S. Patent No. 6,713,092 for an example of proper claim language for a method of making a composition. See U.S. Patent No. 6,193,978 for an example of proper claim language for a method of using a therapeutic composition.

The metes and bounds of Claim 1 are rendered vague and indefinite by the terms, "A1"; "A2"; "A3"; "A4"; "A5"; and, "A6" because it is uncertain as to whether the subject matter of the claimed invention is directed to six compositions of different teas or to one composition comprising each of the claim-designated terms.

With regard to Claim 1, line 13, although the use of common names or traditional/ethnopharmacological names is permissible in patent applications, the standard Latin genus-species name of each ingredient should accompany non-technical nomenclature as a means for identifying the subject botanical noted in this application.

The metes and bounds of Claim 1, line 16, are rendered vague and indefinite by the term, "Good living Tea", because it is unclear as to whether the term is a trademark or not a trademark. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort

made to prevent their use in any manner which might adversely affect their validity as trademarks. It is suggested that each letter of the trademark be capitalized or include a proper trademark symbol, such as <sup>TM</sup> or ®.

Claim 1 is also rendered vague and indefinite by the term, "Good living Tea" because the relationship between a trademark and the product it identifies is often indefinite, uncertain, and arbitrary. The formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trademark. In patent specifications, every element or ingredient of the product should be set forth in positive, exact, intelligible language, so that there will be no uncertainty as to what is meant. Arbitrary trademarks which are liable to mean different things at the pleasure of manufacturers do not constitute such language. *Ex Parte Kattwinkle*, 12 USPQ 11 (Bd. App. 1931).

The metes and bounds of Claim 1, line 16, is rendered vague and indefinite by the term "Good living Tea" because it is uncertain as to what ingredients are contained therein a bag of "Good living Tea". The lack of clarity renders the claim very vague and ambiguous.

Claim 1 recites the abbreviation "min.", in line 17. Although abbreviations are permissible in patent applications, abbreviations in the first instance of the claims should be expanded upon with the abbreviation indicated in parentheses.

The metes and bounds of Claim 1 are rendered vague and indefinite because no period appears at the end of the sentence. Therefore, it is uncertain as to whether

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Applicant intends to direct the subject matter of the instantly claimed invention to other undisclosed limitations.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Rebutan (U), Lust et al. (V), Cho et al. (N), Kawazoe (O), Kubo (P), Hutchens (W) and Moon (\*A).

As discussed above, Applicant's claims are indefinite to the point where a proper search among patent and non-patent literature is almost precluded. However, a search was conducted for what reasonably appears to be Applicant's claimed invention.

Applicant claims A1 a composition of matter of tea comprising: Boiling water; A2 a composition of matter of tea comprising: Chopped dried bitter melon leaves (*Momordica charantia*); A3 a composition of matter of tea comprising: fenugreek (*Trigonella foenum graecum*); A4 a composition of matter comprising: Ground cinnamon (*Cinnamomum cassia*); A5 a composition of matter of tea comprising: dried parsley leaf: (*Petroselinum crispum*); A6 a composition of tea comprising: Pathimukham; B1 a method for making tea comprising: boiling a pot of water; Place one "Good living Tea" bag in a cup and pour hot water; Allow 2 to 3 minutes to steep;

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Add lemon or mint flavor if preferred; Drink as hot tea or add ice cubes to make iced tea.

With regard to A2 wherein Applicant directs the claimed subject matter to a composition of matter of tea comprising chopped dried bitter melon leaves (*Momordica charantia*), Rebultan teaches a composition of tea comprising leaves of bitter melon, which is prepared by bringing a mixture of leaves and fruits in water to a boil, allowing the mixture to simmer, filtering the decoction, and storing it in the refrigerator. The refrigerated tea beverage taught by Rebultan is orally administered for improving the immune system.

With regard to A3 wherein Applicant directs the claimed subject matter to a composition of matter of tea comprising fenugreek (*Trigonella foenum graecum*), Lust teaches a composition comprising fenugreek tea and a method of making thereof comprising decocting fenugreek in water and boiling; administering the tea in an amount of 2 to 3 cups; and adding peppermint oil, lemon extract thereto the tea to improve the flavor.

In another instance, Cho teaches a composition of matter in the form of a tea comprising fenugreek, which has brain blood flow-increasing action and is useful in treating cerebro-vascular disease conditions.

With regard to A4 wherein Applicant directs the claimed subject matter to a composition of matter comprising ground cinnamon (*Cinnamomum cassia*), Kawazoe teaches a health tea comprising cinnamon that is prepared by packing a mixture

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comprising dried bark of *Cinnamomum cassia* into tea bags to prepare the composition for drinking of the tea.

In another example, Kubo teaches a tea comprising *Cinnamomum cassia*; and, a method of making thereof comprising cutting the referenced plant material, and extracting with hot water for 1 hour, and filtering to give a healthy drink

With regard to A5 wherein Applicant directs the claimed subject matter to a composition of matter of tea comprising dried parsley leaf (*Petroselinum crispum*), Hutchens teaches various compositions of tea prepared with leaves of parsley, which are useful in the treatment of various disease conditions of humans.

With regard to A6 wherein Applicant directs the claimed subject matter to a composition of matter of tea comprising Pathimukham, Moon teaches a composition comprising an extract of *Caesalpinia sappan* (also known in the art of herbal medicine as Pathimukham) or a component thereof, which is useful in the treatment of diabetes via oral administration (see Column 3, lines 13-20). In Column 4, line 64 to Column 5, line 18, Moon teaches that the active ingredient of the referenced composition is extractable by boiling out with water. Although Moon does not teach the plant material of *Caesalpinia sappan* or the boiled water containing the plant parts of the claim-designated plant as a tea, a tea is inherent to the composition taught by Moon because it comprises the same ingredient, namely Pathimukham, comprising the composition of matter of tea instantly claimed by Applicant.

The references anticipate the claimed subject matter.



***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rebutan (U), Lust et al. (V), Cho et al. (N), Kawazoe (O), Kubo (P), Hutchens (W) and Moon (\*A).

As discussed above, Applicant's claims are indefinite to the point where a proper search among patent and non-patent literature is almost precluded. However, a search was conducted for what reasonably appears to be Applicant's claimed invention. The Office notes that the instantly claimed invention was rejected under 35 U.S.C. 102(b). However, since the claims are indefinite to the point such that it is uncertain as to the subject matter Applicant intends to direct the instantly claimed invention (see rejection made under 35 U.S.C 112, second paragraph), Claim 1 is also rejected under 35 U.S.C. 103(a).

Applicant's claimed invention was set forth above.

The individual teachings of each of Rebultan, Lust, Cho, Kawazoe, Kubo, Hutchens and Moon are set forth above. Neither Rebultan, Lust, Cho, Kawazoe, Kubo, Hutchens nor Moon teach a composition of matter of tea comprising each of the instantly claimed ingredients. However, it would have been obvious to one of ordinary skill in the art; and, one of ordinary skill in the art would have been motivated and one would have had a reasonable expectation of success to combine the instantly claimed ingredients in the making of a composition of matter of tea comprising each of bitter melon leaves, fenugreek, ground cinnamon, parsley leaf and pathimukham to provide the instantly claimed composition because at the time the invention was made the beneficial health promoting effects of each of the claim-designated ingredients in the form of tea were known in the art, as evidenced by the teachings of Rebultan, Lust, Cho, Kawazoe, Kubo, Hutchens and Moon.

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Accordingly, the claimed invention was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, especially in the absence of evidence to the contrary.

\* Applicant is advised that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)), from the Office of Public Records and from commercial sources. Should you receive inquiries about the use of the Office's PAIR system, applicants may be referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Flood whose telephone number is 571-272-0964. The examiner can normally be reached on 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michele Flood  
Primary Examiner  
Art Unit 1655

MCF  
March 20, 2006

  
**MICHELE FLOOD**  
**PRIMARY EXAMINER**